

## REMARKS

Claims 1-20 are pending in the present application. Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,718,298 B1 ("Judge") in view of U.S. Patent No. 6,671,353 B1 ("Goh") and further in view of International Application Publication No. WO 97/01932 ("Bruno"). Applicant respectfully traverses the rejection for at least the reasons as set forth below.

### I.

Applicant respectfully submits that Bruno was improperly combined with Judge and Goh.

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is not suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01(V).

Note, please, that Applicant is not making a naked conclusion that there is no suggestion to combine. On the contrary, Applicant is merely adopting the conclusion presented by the M.P.E.P. The M.P.E.P. is making the conclusion that there is no suggestion to make the proposed modification **if** Applicant can show that the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.

Therefore, since we are already under Final Rejection, please do not respond in an Advisory Action with the typical Office boilerplate that begins *"In response to applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references ...."*

It is not applicable. Applicant is not making a naked statement that there is no suggestion to combine the references. **On the contrary, Applicant is adopting the conclusion of the**

**M.P.E.P.** An Advisory Action should properly address the conclusion as set forth in M.P.E.P. § 2143.01(V).

Goh states that its intended purpose at col. 1, lines 37-39: “It is, therefore, an object of the present invention to provide a method for recording a short voice memo during a call *on a portable telephone*” (italics added).

Goh also states that its intended purpose at col. 1, lines 40-42: “It is another object of the present invention to provide a method for reproducing a short voice memo recorded *in a portable telephone*” (italics added).

However, the recited elements of the claims that the Office Action Made Final relied upon in Bruno occur in a centralized wired common multipoint control unit (MCU) 26. First, the centralized wired common MCU 26 is connected, in a wired system 10, to three wired work stations 14 and a wired telephone 34 as set forth in FIG. 1 of Bruno. The telephone 34 is an audio-only wired telephone 34 and does not perform any of the functions of the centralized wired common MCU 26. Note that, although a wired telephone 34 is disclosed in Bruno, Bruno teaches that the functionality is in the centralized wired common MCU 26 and that a multimedia conference call is stored in a wired digital computer 32 that is dedicated to the centralized wired common MCU 26.

Thus, if the teachings of Goh were modified by the teachings of Bruno, the wired centralized common multipoint control unit (MCU) 26 (which is distinguished from the audio-only telephone 34 of Bruno) would make inoperable the portability of the portable telephone as described in Goh since Bruno teaches that, between a telephone 34 and an MCU 26, it is the MCU 26 and not the telephone 34 that stores a multimedia conference call from three wired workstations 14 into a dedicated and separate wired digital computer 32.

Thus, it is respectfully submitted that since the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is not suggestion or motivation to make the proposed modification”. M.P.E.P. § 2143.01(V).

For at least the above reasons, it is respectfully submitted that Bruno was improperly combined with Goh.

It is therefore respectfully requested that the rejection of claims 1-30 based, at least in part, on the combination of the teachings of Goh and Bruno be withdrawn with respect to claims 1-30.

## II.

Judge states that its intended purpose is to avoid an “unacceptably large memory” in a GSM mobile telephone. In fact, Judge already laments the “amount of memory that has been provided” “to record a voice memo” “or to record a conversation”. See, e.g., Description of the Related Art section of Judge.

In view of the need of Judge to keep memory use to a minimum in a GSM mobile telephone, it appears to be counterproductive to combine the teachings of Bruno in which video is also stored. Of course, in Bruno, the storage of video requires a large storage device in a separate wired digital computer 32 that is dedicated to a centralized wired common MCU 26.

The storage of video would make the GSM mobile telephone in Judge unsatisfactory for its intended purpose.

First, the teaching of the storage of video in Bruno on top of the teachings of storing a voice memo in Judge would be unacceptable to the teachings of Judge in which Judge attempts to keep memory usage to a minimum and in which Judge attempts to avoid an unacceptably large memory in a GSM mobile telephone. Since Bruno teaches the use of a separate wired digital computer 32 dedicated a centralized wired common MCU 26 to store video, Bruno teaches that such video cannot be stored in a small memory of a GSM mobile telephone as taught in Judge. Evidence of this can be found, for example, in the fact that Bruno does disclose a telephone 34 connected to the MCU 26 that has a dedicated digital computer 32 and yet the functionality resides in the MCU26/dedicated digital computer 32 and not in the telephone 34 of Bruno. Furthermore, the storage of video is memory-use intensive which would make unsatisfactory the intended purpose of Judge which is to keep memory usage to a minimum and to avoid large memories in a GSM mobile telephone. On the other hand, Bruno teaches that multimedia is so memory-use intensive that a separate digital computer 32 is dedicated to the MCU 26. Again, it

is noted that Bruno teaches that the storage occurs in a separate, dedicated digital computer 32 and not in the disclosed telephone 34.

Second, as mentioned before, the storage of video occurs in the wired common multipoint control unit (MCU) 26 and not in the audio-only telephone 34 of Bruno. In fact, the wired system 10 of Bruno appears to be completely wired and thus teaches away from mobility. Thus, to combine the teachings of Bruno with the teachings of Judge would destroy the mobility of the GSM mobile telephone.

Thus, it is respectfully submitted that since the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is not suggestion or motivation to make the proposed modification”. M.P.E.P. § 2143.01(V).

For at least the above reasons, it is respectfully submitted that Bruno was improperly combined with Judge.

It is therefore respectfully requested that the rejection of claims 1-30 based, at least in part, on the combination of the teachings of Judge and Bruno be withdrawn with respect to claims 1-30.

### III.

Applicant respectfully submits that Bruno and Goh teach away from each other, Bruno and Judge teach away from each other, and thus were improperly combined.

“A prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness ....” M.P.E.P. § 2145(X)(D)(1). “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.02(VI).

Goh teaches a simple *portable* telephone for “recording a short voice memo”. Judge teaches a GSM *mobile* telephone that records a voice memo or records a conversation.

Bruno teaches away from the portable telephone of Goh and teaches away from the mobile telephone of Judge. Instead, Bruno teaches that a wired centralized common MCU 26 must be connected to a wired digital computer 32 because the wired digital computer 32 records a multimedia conference call from three work stations 14. The wired centralized common MCU

26 is neither mobile nor portable as contemplated by Goh or Judge. It must be noted that Bruno does disclose an audio-only telephone 34, but that the storage of the multimedia conference call occurs in a separate wired digital computer 32 dedicated to the wired centralized common MCU 26.

Since Bruno teaches away from Goh and Judge, it is respectfully submitted that Goh and Judge were improperly combined with Bruno.

It is therefore respectfully requested that the rejection of claims 1-30 based, at least in part, on the combination of the teachings of Judge and Bruno be withdrawn with respect to claims 1-30.

#### IV.

Applicant does not necessarily agree or disagree with the Examiner's characterization of the documents made of record, either alone or in combination, or the Examiner's characterization of recited claim elements. Furthermore, Applicant respectfully reserves the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

With respect to the present application, Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

U.S. Application No. 10/651,428, filed August 29, 2003

Attorney Docket No. 17405US04

Response AF dated March 31, 2008

In Response to Office Action Made Final mailed January 29, 2008

Dated: March 31, 2008

Respectfully submitted,

/Michael T. Cruz/

Michael T. Cruz

Reg. No. 44,636

McAndrews, Held & Malloy, Ltd.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
Telephone: (312) 775-8084  
Facsimile: (312) 775-8100